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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,288	04/07/2000	Stephane Ayala	032326-057	1602
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EXAMINER TRINH, MINH N				
ART UNIT 3729		PAPER NUMBER		
NOTIFICATION DATE 08/04/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

09/545,288

Applicant(s)

AYALA ET AL.

Examiner

Minh Trinh

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-24, 27, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) 6-12 and 29 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45 and 46 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 14-23 is/are rejected.
- 7) ☒ Claim(s) 4, 13 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notices of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of an RCE filed on 2/23/09 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2 and 14, 15-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the specification discloses the insulating bridge 13 (page 7, lines 3-6) for connecting antenna ends to connecting pads but fail to disclose whether the antenna ends and the pads to be electrically connected.

4. Claims 1-2, 14 and 15-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not known whether or not the antenna ends can be electrically connected to its associated pad by a bridge since a bridge is being the insulating bridge (see claim 1, lines 6-8).

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by McDonough et al (5920290).

McDonough discloses the method comprising steps: producing, on a support sheet 18, the antenna 21 with at least two turns and a pair of connection pads 20a-20b that are both disposed on the support sheet on a common side of said antenna turns (see Fig. 4), and electrically connecting at least one of the ends of the antenna to a respective one of said connection pads by means of a bridge disposed on a surface of said turns that is away from said support sheet (see related Figs. 2-4).

As applied to claim 2, where the bridge is produced by covering the turns of the antenna with an insulating layer in one zone and depositing on this insulating layer a conductive element so that one end of the antenna can be connected to one connection pad (see Fig. 2, the bridge 22 being covering 20-21).

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Fidalgo (5,598,032) in view of McDonough et al.

Fidalgo discloses a method for manufacturing smart card having at least two antenna turns 5, a pair of connection pads 15 that are both disposed on a support sheet 3 on the common side of the antenna turns (note that both antenna turns and pads are on same size of the support sheet 3). If argues that Fidalgo do not teach the connecting at least one of the ends of the antenna to a respective one of said connection pads by means of a bridge. Then refer to Dononough's Fig. 4 for the teaching of connection pads 20a-20b that are both disposed on the support sheet on a common side of said antenna turns and the bridge 22 that connect the antenna turns to the pads (see Figs. 2-3). Therefore, it would have been obvious to modify the Fidalgo by incorporated the teaching of Dononough et al in order to accommodate direct electrical contact between the conductors pad and the antenna turns elements by utilizing the convenience and perhaps available techniques.

Furthermore, col. 4, about lines 6-10 of the Fidalgo teaches the electrical interconnection of 5, 15 and contact zone 12 as pads, etc.

As applied to claim 2, noting related embodiment such as Fig. 5 of the Fidalgo shows the insulation covering the antenna turns 5 in one zone as right hand side of Fig. 3 further the other zone as opposed to the one zone where a conductive element as 11 being connected to the outer end as top of the antenna 5 (see related Fig. 5 and the discussion at col. 3, lines 64-to col. 4, line 5).

7. Claims 14 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dononough et al or Fidalgo /Dononough et al as modified above.

As applied to claim 14, regarding the module is formed by a solder with a low melting point. As applied to claim 14, it is inherent that to use low melting solder for connection module to the antenna in order to protect the extremely heat that may damage to the forming device.

As applied to claims 15-20, it would have been obvious to one having skill in the art to incorporate the use of particular materials as recited in these claims since it was known in the art that selecting a material from a host of group of available materials on the basis of its suitability for the intended use as a matter of obvious design choice.

Limitations of claims 16-20 are similar to that as discussed above.

As applied to claims 21-23, it would have been an obvious matter of design choice to choose any desired means for connection between the connection pads of the antenna and the conductive pads of the module including the use of grease charged, silicon gasket charged, and/or additional gold deposited by thermal compression since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the conventional bonding techniques as taught by each of the prior art reference (i.e., see the discussion of Fidago at cols. 5-6).

Response to Arguments

8. Applicant's amendment filed on 2/23/09 have been fully considered and made of record however, such amendment do not overcome the 112 rejection set forth above.

9. Claims 4, 13 and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. Claims 45-46 are allowed (see reasons as provided from Advisory Action dated 2/2/07).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of manufacturing chip card or smart card devices.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Minh Trinh/
Primary Examiner, Art Unit 3729

mt
5/7/09